

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



In the Patent Application of	)	
	)	Group Art Unit: 2651
Tetsuhiro SHIOMI	)	
	)	
Serial No. 09/476,776	)	Examiner: Chu, K.
	)	
Filed: December 30, 1999	)	

For: Apparatus and Method for Adjusting the Tilt Angle of  
an Optical Pickup Device

Commissioner of Patents  
BOX DAC  
Washington, D.C. 20231

PETITION UNDER 37 C.F.R. § 1.181

Sir:

Appellant hereby petitions for withdrawal of the Examiner's new ground of rejection in the Final Rejection mailed in the above-identified application on May 8, 2001 (Paper No. 8). This is a petitionable issue because Appellant seeks review of the permissibility of the new ground of rejection.

MPEP § 706.07(a) states, "A second or any subsequent action on the merits. . . should not be made final if it includes a rejection, on the prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed." In this case, the added limitation to claim 1 was already claimed in originally-filed claim 8, yet the Examiner set forth a new ground of rejection in the May 8, 2001 Final Office Action by presenting the Sugiura reference for the first time during this prosecution.

The Examiner admitted in the July 20, 2001 Advisory Action that Sugiura was a new reference and admitted that "this amended feature already presented in the claim 8", but asserted that "this feature does not overcome the 102 rejection of Takizawa's '497 patent [U.S. Patent No 5,311,497]" (July 20, 2001 Advisory Action, item 4). Whether or not the "without a tilt sensor input" feature overcomes a § 102 rejection, however, is not relevant to whether the Examiner's final rejection under § 103, which adds the Sugiura reference, was proper. In fact, the Examiner's May 8, 2001 Final Rejection did not contain any § 102 rejections, so the Examiner's remarks regarding whether the amendment overcomes a § 102 rejection are not even relevant to the Final Rejection. The Examiner cannot assert that claim 1 fails to overcome a § 102 rejection based on Takizawa (July 20, 2001 Advisory Action) and at the same time admit that Takizawa does not teach the control circuit recited in claim 1, necessitating the new grounds of rejection (May 8, 2001 Final Rejection, p. 5).

The Examiner has not adequately explained how the finality of the May 8, 2001 rejection was proper when the Examiner (1) admitted that Takizawa does not teach all of the limitations of claim 1; (2) admitted that the "without a tilt sensor input" limitation added to claim 1 was already in originally-filed claim 8; and (3) admitted that Sugiura was a newly-cited reference. It was reasonable to expect that claim 1 may be amended to include the "without a tilt sensor input" limitation when it was already explicitly recited in originally-filed claim 8.

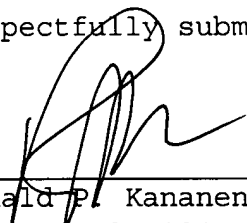
Thus, introduction of the Sugiura reference in the Final Office Action constitutes an impermissible new ground of rejection under MPEP § 706.07(a) because the Examiner relies upon Sugiura to show a teaching that was not present in any of the originally-cited references. The Examiner should not be allowed, at this stage of prosecution, to rely upon the teachings of a new reference for the first time to remedy a deficiency in his previous Office Action.

Because the May 8, 2001 Final Office Action presents the Sugiura reference for the first time to show a previously considered limitation, the finality of the May 8, 2001 Office Action is improper and should not be sustained. Appellant therefore petitions the Commissioner under 37 C.F.R. § 1.181 to direct the Examiner to withdraw the new ground of rejection relying on the Sugiura reference or, in the alternative, withdraw the above-referenced case from Appeal and reopening prosecution so that the Sugiura reference can be properly made of record and considered.

No fee is believed to be required to support this Petition. However, if any additional fees are required, they may be charged to Deposit Account 18-0013 in the name of Rader, Fishman & Grauer PLLC.

Respectfully submitted,

Dated: November 26, 2001

By   
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